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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,743	10/23/2003	Gary H. Knauf	56765.DI	8264
408	7590	04/20/2005	EXAMINER	
LUEDEKA, NEELY & GRAHAM, P.C. P O BOX 1871 KNOXVILLE, TN 37901				TORRES VELAZQUEZ, NORCA LIZ
		ART UNIT		PAPER NUMBER
		1771		

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/691,743	KNAUF, GARY H.
	Examiner	Art Unit
	Norca L. Torres-Velazquez	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 January 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13-20 and 22-29 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 13-20 and 22-29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 13-20 and 22-29 have been considered but are moot in view of the new ground(s) of rejection.

a. Applicant has amended claim 13 to recite a lightweight web, which has insufficient strength to allow the web to be effectively extrusion coated using conventional extrusion systems without substantial deformation thereof. Applicant further argue that the cited references of Liu, Peer, Hurst and Selin do not disclose the use of a carrier web together with a lightweight web onto which a layer is applied by extrusion coating and the subsequent separation of the extrusion coated lightweight web from the carrier web. Applicant further indicate that the cited references do not disclose a process of extrusion coating a layer onto a "lightweight" web which is itself incapable of being extrusion coated.

Applicant's arguments are noted, however, Applicant's arguments with regards to claims 13-20 are not commensurate in scope with the claims since the product as claimed does not require the a carrier web. Therefore, the Examiner maintains the rejection of claims 13-20 as stated in previous action since the present claims do not require a carrier web as implied by applicant in arguments. With regards to new claims 22-29, Backwell (US 3,620,872) is cited herein that teaches the process of making an extrusion coated material by a method that uses a carrier web producing a similar structure to that claimed herein.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-20 and 23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The carrier web is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Specification of the present invention teaches that the use of a carrier web is essential to the practice of the present invention; this is supported in page 2, first paragraph and in the Figures of the present application.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-20 and 22-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over BACKWELL (US 3,620,872).

BACKWELL discloses a method of processing web material supported on a carrier and subsequently separating the processed web and carrier. (Abstract) The reference teaches using a carrier web to obviate the processing problems such as extensibility and heat distortion during the coating of web materials. (Col.1, lines 6-11) The reference teaches the use of coating such

as polyolefins. (Col. 1, lines 49-52) And teaches applying the coating material by methods such as melt extrusion. (Col. 1, lines 47-48) The layer or layers of material to form the finished self-supporting assembly may be of such polymers as polyethylene or polypropylene, ethylene-vinyl acetate copolymer or vinylidene chloride copolymers. The reference also teaches regenerated cellulose film, paper, board, metal foil or other material to which it is desired to apply a coated finish. (Col. 1, lines 59-64) The method taught by Backwell comprises: providing a reusable carrier (Col. 1, lines 6-16) such as endless carrier or a reel-to-reel carrier web. (Col. 1, lines 39-40), applying to said carrier a coating of polymeric material by such methods as melt extrusion (Col. 1, lines 47-49), the coating in itself being non-self-supporting but being capable of subsequent separation from the carrier when the coating has become part of a self-supporting assembly (i.e. coating forms claimed lightweight web) (Col. 1, lines 17-22), applying to the coating of polymeric material an adhesion promotion layer (Col. 1, line 21; Col. 2, lines 9, 45, 69), and applying to the adhesion promotion layer at least one further layer of polymeric material by e.g. an extrusion coating (the claimed polymer film coating). (Col. 1, lines 56-67; Col. 2, line 10), whereby forming a self-supporting assembly, and subsequently separating said assembly from said carrier (See Col. 1, lines 22-27). The layers of material to form the finished self-supporting assembly (i.e. both claimed lightweight web and the polymer film coating) may be of such polymer as polyethylene, polypropylene, ethylene-vinyl acetate copolymer or vinylidene chloride copolymers or regenerated cellulose film, paper, board, metal foil or other material to which it is desired to apply a coated finish. (Col. 1, lines 59-64) The coating of polymeric material may be of ethylene-vinyl acetate copolymer (See column 2, lines 45-47), polyethylene (See column 2, lines 10, 69-70). With regards to the basis weight of the materials in claim 23, it

is noted that the reference teaches values that fall within the claimed ranges. (Refer to Examples)

Although BACKWELL does not explicitly teach the claimed MD curl it is reasonable to presume that the claimed MD curl is inherent to BACKWELL. Support for said presumption is found in the use of like materials (i.e. a lightweight web in the form of a non self-supporting coating, an extrusion coated polymeric material, the coated product made by using a carrier web for support that is subsequently separated from the processed web). The burden is upon Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of a MD curl of less than about 3 inches would obviously have been present one the BACKWELL product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

7. Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by LIU et al. (US 5,510,180) as stated in previous action.
8. Claims 13-15 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PEER, Jr. (US 4,254,173) as stated in previous action.
9. Claims 13, 15 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HURST (US 3,230,135) as stated in previous action.
10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over HURST as applied to claim 13 above, and further in view of SELIN et al. (US 6,153,306) as stated in previous action.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Norca L. Torres-Velazquez  
Examiner  
Art Unit 1771

April 18, 2005